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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,215	03/24/2006	Dieter Doehring	BARDP0126US	4813
23908 7590 04/07/2009 RENNER OTTO BOISSELLE & SKLAR, LLP 1621 EUCLID AVENUE NINETEENTH FLOOR CLEVELAND, OH 44115				
EXAMINER O HERN, BRENT T				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/595,215

**Applicant(s)**

DOEHRING, DIETER

**Examiner**

Brent T. O'Hern

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 8-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-11 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claims***

1. Claims 1-4, 8-14 and 16-18 are pending with claims 12-14 withdrawn and claims 16-18 new.

## **WITHDRAWN OBJECTIONS/REJECTIONS**

2. All objections/rejections of record in the Office Action mailed 9/22/2008 have been withdrawn due to Applicant's amendments in the Paper filed 1/22/2009.

## **NEW REJECTIONS**

### ***Claim Rejections - 35 USC § 112***

3. Claims 1-4, 8-11 and 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "by applying to the particles a liquid composed substantially of the adhesion promoter" in claim 1, lines 5-6 is vague and indefinite since it is unclear whether the liquid has an adhesion promoter or almost an adhesion promoter or a material that is similar to an adhesion promoter.

The phrase "then the adhesion promoter has been dried" in claim 1, line 6 is vague and indefinite since it is unclear whether it is the "adhesion promoter" or a "liquid" containing an adhesion promoter that is dried. Furthermore, it is unclear what process step Applicant is attempting to set forth and whether "has been" refers to a drying step before the liquid is applied or is it a step after the coating is applied. If it is referring to a

process step then it is unclear how the coating can be dried in the past before the coating is applied.

***Claim Rejections - 35 USC § 102/103***

4. Claims 1-4, 10-11 and 17-18 are is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dohring (WO 00/44984) published August 3, 2000 with evidence by Dohring (US 6,835,421) which is interpreted as being the English equivalent of ('984) and claims priority to ('984).

Regarding claims 1-4,11 and 17-18, Dohring ('984) teaches paper for a laminate panel with a paper provided with a décor and is impregnated with an amino resin for forming a resin matrix and comprises abrasion-resistant particles having a diameter of 50 to 200  $\mu\text{m}$ /(90 to 130  $\mu\text{m}$ ) made of silicon carbide or aluminum oxide that are coated with a silane adhesion promoter and are integrated into the resin matrix (*See col. 1, l. 47 to col. 2, l. 11 and Abstract.*) and inherently teaches the same structure as if the abrasion-resistant particles have been coated per the process steps in claim 1, lines 4-7 with the adhesion promoter by applying to the particles a liquid composed substantially of the adhesion promoter and then the adhesion promoter has been dried to form the coating before the abrasion-resistant particles are applied to the paper (*See col. 1, l. 47 to col. 2, l. 11 and Abstract where the structure for the paper is the same whether or not the adhesion promoter has dried to the particles before or after the particles are integrated into the resin matrix. In both situations the adhesion promoter is on the particles and the resin integrates the coated particles into the structure. Applicant does*

*not set forth any evidence of how the structure is different when produced by the alternative methods.*). In the alternative, a person having ordinary skill in the art would obviously appreciate or provide the coated particles by either method since the finished products are provided by either the same or substantially the same. Thus, a rejection under 35 USC 102/103 is proper (*See MPEP 2112.*).

The phrase "wherein the further resin and the decor is pressed with an overlay or fibers, and the overlay or the fibers are impregnated with a pure amino resin" in claim 18, lines 1-3 is interpreted as not further limiting the structure beyond that as discussed above. Nothing in the claims states the overlay or fibers or amino resin is integrated with or part of the paper but rather are interpreted as extraneous materials that may have temporarily contacted the paper material.

Regarding claim 10, Dohring ('984) inherently teaches the abrasion resistant particles being in a plane (*See col. 1, l. 47 to col. 2, l. 11 and Abstract where the paper is planar, thus, providing for the particles being embedded within the paper to also be in a planar orientation.*). In the alternative, a person having ordinary skill in the art would obviously appreciate or provide the particles in a plane in order to provide a planar subject useful in a laminate. Thus, a rejection under 35 USC 102/103 is proper (*See MPEP 2112.*).

5. Claims 1-4, 8-11 and 17-18 are rejected under 35 U.S.C. 102(a) as being anticipated by Dohring et al. (US 2003/0138600).

Regarding claims 1-4, 8-9, 11 and 17-18, Dohring ('600) teaches paper for a laminate panel with a paper filled with an acrylate provided with a décor having a weight

of 20 to 60 g/m<sup>2</sup> and is impregnated with an amino resin for forming a resin matrix and comprises abrasion-resistant particles having a diameter of 50 to 200  $\mu\text{m}$  (90 to 130  $\mu\text{m}$ ) made of silicon carbide or aluminum oxide that are coated with a silane adhesion promoter and are integrated into the resin matrix (*See paras. 20-31.*) and inherently teaches the same structure as if the abrasion-resistant particles have been coated per the process steps in claim 1, lines 4-7 with the adhesion promoter by applying to the particles a liquid composed substantially of the adhesion promoter and then the adhesion promoter has been dried to form the coating before the abrasion-resistant particles are applied to the paper (*See paras. 20-31 where the structure for the paper is the same whether or not the adhesion promoter has dried to the particles before or after the particles are integrated into the resin matrix. In both situations the adhesion promoter is on the particles and the resin integrates the coated particles into the structure. Applicant does not set forth any evidence of how the structure is different when produced by alternative methods.*). In the alternative, a person having ordinary skill in the art would obviously appreciate or provide the coated particles provided by either method since the finished products are either the same or substantially the same. Thus, a rejection under 35 USC 102/103 is proper (*See MPEP 2112.*).

Regarding claim 10, Dohring ('600) inherently teaches the abrasion resistant particles being in a plane (*See paras. 20-31 where the paper is planar, thus, providing for the particles being embedded within the paper to also be in a planar orientation.*). In the alternative, a person having ordinary skill in the art would obviously appreciate or

provide the particles in a plane in order to provide a planar subject useful in a laminate.  
Thus, a rejection under 35 USC 102/103 is proper (*See MPEP 2112*).

***Claim Rejections - 35 USC § 103***

6. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohring (WO 00/44984) published August 3, 2000 with evidence by Dohring (US 6,835,421) which is interpreted as being the English equivalent of ('984) and claims priority to ('984) in view of Jaisle et al. (US 4,473,613).

Dohring ('984) teaches the paper discussed above, however, fails to expressly disclose the paper having a weight of 20 to 60 g/m<sup>2</sup> and being filled with an acrylate.

However, Jaisle ('613) teaches providing an acrylate filled paper having a décor having a weight of 20 to 60 g/m<sup>2</sup> (*See Abstract, col. 2, ll. 52-68. col. 3, ll. 31-37 and col. 4, ll. 35-40.*) for the purpose of providing a material that easy to form, resistant to discoloration, can be printed and is useful in high or low pressure laminates (*See col. 4, ll. 35-40.*).

Therefore it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to use an acrylate filled paper having the above weight as taught by Jaisle ('613) in Dohring ('984) in order to provide a product that is easy to form, resistant to discoloration, can be printed and is useful in various types of laminates.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dohring (WO 00/44984) published August 3, 2000 with evidence by Dohring (US 6,835,421) which is interpreted as being the English equivalent of ('984) and claims priority to ('984)

in view of Shirono et al. (WO 01/21529) with Shirono et al. (US 6,994,834) interpreted as being the English equivalent of ('529).

Dohring ('984) teaches the paper discussed above, however, fails to expressly disclose the silane adhesion promoter being an amino silane adhesion promoter.

However, Shirono ('529) teaches using an amino silane adhesion promoter for modifying silica powder (*See Abstract and col. 2, ll. 29-67.*) for the purpose of significantly increasing the adsorption amount of the anion source (*See col. 2, ll. 63-67.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to use an amino silane adhesion promoter as taught by Shirono ('529) in Dohring ('984) in order to provide a paper having particles with increased adsorption capacity.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dohring et al. (US 2003/0138600) in view of Shirono et al. (WO 01/21529) with Shirono et al. (US 6,994,834) interpreted as being the English equivalent of ('529).

Dohring ('600) teaches the paper discussed above, however, fails to expressly disclose the silane adhesion promoter being an amino silane adhesion promoter.

However, Shirono ('529) teaches using an amino silane adhesion promoter for modifying silica powder (*See Abstract and col. 2, ll. 29-67.*) for the purpose of significantly increasing the adsorption amount of the anion source (*See col. 2, ll. 63-67.*).



Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to use an amino silane adhesion promoter as taught by Shirono ('529) in Dohring ('600) in order to provide a paper having particles with increased adsorption capacity.

#### **ANSWERS TO APPLICANT'S ARGUMENTS**

9. In response to Applicant's arguments (*See p. 4, paras. 3-7 of Applicant's Paper filed 1/22/2009.*) regarding the new limitations, it is noted that said limitations are discussed above.
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571)272-0496. The examiner can normally be reached on Monday-Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BTO/  
Brent T. O'Hern  
Examiner  
Art Unit 1794  
March 28, 2009

/Elizabeth M. Cole/  
Primary Examiner, Art Unit 1794